



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		20-540	
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	09/941,582	August 30, 2001	
	First Named Inventor		
	LIBMAN		
	Art Unit	Examiner	
	2155	Bruckhart, B.	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 36,457 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <u>5</u> forms are submitted.</p>			

Signature

William H. Bollman

Typed or printed name

202-261-1020

Telephone number

October 12, 2006

Date

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/941,582

Filed: August 30, 2001

Group Art Unit: 2155

Examiner: Bruckart, Benjamin R.

Atty Docket No.: 20-540

IN RE PATENT APPLICATION OF:

LIBMAN

TITLE: **CONVERTING REAL-TIME TEXT MESSAGES (AS AMENDED HEREIN)**

October 12, 2006

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Office Action dated June 7, 2006 and the Advisory Action dated August 15, 2006, please enter the following remarks in the subject application:

REMARKS

Claims 1-58 remain pending in the application.

Claims 1, 4-21 and 24-58 over Matsumoto in view of Kanevsky

Claims 1, 4-21 and 24-58 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 6,678,720 to Matsumoto ("Matsumoto") in view of U.S. Patent Application Publication No. 2002/0069069 to Kanevsky et al. ("Kanevsky"). The Applicant respectfully traverses the rejection.

The Examiner continues to frustrate the Applicants with a rejection ignores claimed features, ignores what the cited prior art discloses, combines the elements from the cited prior art to recreate the claimed features without suggestion within the cited prior art and fails to provide motivation why one skilled in the art would modify the primary reference.

Claims 1, 4-21 and 24-58 recite a system and method to convert/transfer an instant message and a chat history from a first data format that is compatible with a first real-time chat system to a second data format that is compatible with a second real-time chat system.

The Examiner acknowledged that Matsumoto does not disclose a second system that is a real time instant messaging system (see Response to Arguments section of the Office Action dated June 7, 2006, page 20). However, the Examiner alleged that Matsumoto discloses voicemail at col. 2, line 64 that can be heard in real-time and is generally part of a chat system like a phone (see Response to Arguments section of the Office Action dated June 7, 2006, page 20). The Applicants respectfully disagree.

Matsumoto fails to disclose voicemail of any kind. Matsumoto discloses at col. 2, line 64, and throughout the disclosure, the use of voice data. Moreover, even if the Examiner were to equate Matsumoto's voice data to voicemail, without support in Matsumoto, Matsumoto's second information terminal is disclosed as being an ordinary information terminal, i.e., a telephone set or fax machine on a telephone circuit network, or a PC independent of the

Internet (see col. 2, lines 57-59). Matsumoto discloses text data is converted to voice data for review on a telephone (see col. 10, lines 12-21). However, Matsumoto fails to disclose or suggest conversion of a user's voice data into a text message for participation in a real-time chat system. Matsumoto fails to disclose a second real-time chat system, much less conversion/transfer of an instant message and a chat history in a second data format compatible with a second real-time chat system, as recited by claims 1, 4-21 and 24-58.

Moreover, Matsumoto actually **TEACHES AWAY** from use of a second real-time chat system. Matsumoto's second information terminal is disclosed as being an "ordinary information terminal", i.e., a telephone set or fax machine on a telephone circuit network, or a PC independent of the Internet (see col. 2, lines 57-59) that **LACKS** real-time chat capability. Modifying Matsumoto's second information terminal to be a real-time chat system that has instant messaging capability defeats the whole purpose of Matsumoto's invention to use an information terminal that does not have instant messaging capability and does not have the ability to be used as a real-time chat system to monitor instant messaging from a real-time chat system.

Moreover, "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). As discussed above, Matsumoto in fact teaches away from the Examiner's proposed modification of Matsumoto. Matsumoto nor Kanevsky suggest the Examiner's modification of Matsumoto's telephone set or fax machine to instead be an instant messaging real-time chat system, as recited by claims 1, 4-21 and 24-58.

Moreover, the Examiner alleged that a phone is part of a chat system. However, Applicant's claims are directed toward an instant message compatible with a real-time chat system. Thus, the Examiner is ignoring claimed features and a reading of the entire claim limitation reveals that the claimed features do not read on Matsumoto's use of a phone that is only used to monitor

a chat. Matsumoto's chat monitor has nothing to do with Applicants' claimed instant messaging and real-time chat system.

Moreover, the Examiner has failed to address much less refute the Applicant's previous argument that the Examiner's motivation for modifying Matsumoto with the disclosure of Kanevsky "to connect disparate chat service systems (Kanevsky, col. 1, lines 11; last line)" (See Office Action dated June 7, 2006, page 3) is improper. The Examiner's motivation is why Kanevsky came up with his invention **NOT** a reason to modify Matsumoto. The Examiner has still failed to provide a reason why one skilled in the art would modify Matsumoto in any way, much less with any disclosure from Kanevsky. Applicants traverse the Official Action as incomplete because it fails to answer the material traversed. (See MPEP §707.07(f)).

Moreover, Kanevsky appears to disclose an Integration Server that receives all of the participant's chat messages, which have various formats, and translates them into a format used by the chat service system of the deaf or hearing-impaired participant (See Kanevsky, Abstract). However, Kanevsky fails to disclose or suggest conversion/transfer of an instant message **AND** a chat history. Thus, neither Matsumoto nor Kanevsky disclose or suggest conversion/transfer of an instant message **AND** a chat history between two **real-time** systems, as recited by claims 1, 4-21 and 24-58.

The Examiner alleged that Kanevsky discloses both instant messages and chat histories, with chat histories being used when a transcript of a message is received and interpreted by the system from the ASR and when the system translates the transcript of two other people's conversation for someone's chat service system at paragraph 11. However, the transcription that the Examiner refers to is a text from a real-time conversation occurring within the teleconference, similar to real-time messages flowing within a conventional instant messaging chat system. Kanevsky fails to disclose or suggest conversion/transfer of TWO different types of data between two **real-time** chat systems, i.e., an instant message **AND** a chat history between two **real-time** chat systems, as recited by claims 1, 4-21 and 24-58.

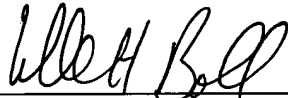
Thus, Matsumoto in view of Kanevsky fails to disclose, teach or suggest conversion/transfer of an instant message AND a chat history between two real-time chat systems using different data formats, as recited by claims 1, 4-21 and 24-58.

Accordingly, for at least all the above reasons, claims 1, 4-21 and 24-58 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,



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